

REMARKS

Claims 1-24 remain in this application. Claims 2 and 12 have been amended to delete the phrase “generally spherical”. Claim 9 has been amended to correct informalities identified by the Examiner. Claim 13 has been amended to remove language (“generally spherical”) found objectionable in claims 2 and 12 and to conform to antecedent basis.

Claim Objections

The Examiner objected to claim 9 because of informalities. The Examiner suggested that “of” be inserted before “longitudinally” in line 3 and “the” be deleted from before “forward and reverse directions” in line 5. The Applicants have made the suggested changes. Accordingly, withdrawal of the objection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse these rejections.

Specifically, the Examiner asserts that the term “essentially” in claim 1 is a relative term which renders the claim indefinite. The Examiner further states that the term “essentially” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised at the scope of the invention. Applicants respectfully point out that the term “essentially” is, in fact, defined in the specification. Referring to paragraph 0056 on page 12 of the application, the specification states that “the invention is intended to cover those toy vehicles capable of essentially performing the same maneuvers, at least on a level surface, even if there is some minor contact or interference of the tractor with the trailer in passing under the trailer as long as the tractor can pass under the trailer without jackknifing or turning over the trailer or lifting the trailer off all its road wheels.” (emphasis added) Because “essentially” is defined in the specification, Applicants contend that the use of the term in claim 1 does not render it indefinite.

The Examiner rejected claims 2 and 12 because the term “generally” is a relative term which renders the claims indefinite. The Examiner further states the “spherical base member” and the “spherical socket” have been rendered indefinite by of the use of the term “generally”.

Applicants have amended claims 2 and 12 to remove the phrase “generally spherical” from the claim language. While Applicants traverse the rejection as unsupported, since the proposed amendment broadens the claims, the amendment will not restrict the scope of equivalence of the claim when it is allowed. The foregoing amendments to claims 2 and 12 render claims 2 and 12 definite, over under the Examiner’s interpretation. Claim 13 is also amended to remove “generally spherical”.

For the foregoing reasons, it is respectfully submitted that claims 1 through 12 are in full compliance with 35 U.S.C. § 112, second paragraph. Accordingly, reconsideration and withdrawal of the rejections to claims 1 through 12 are respectfully requested.

Restriction Requirement

In response to the Examiner’s Rejection (sic.) Requirement dated August 7, 2003 (Paper No. 6), Applicants elected Group I, claims 1-12, with traverse, the grounds of which were stated in the Response to the Restriction Requirement sent via facsimile on September 8, 2003. However, the Examiner failed to make the restriction final or respond to the traverse of the restriction. Instead, he merely examined claims of Group I. Applicants again request reconsideration and withdrawal of these requirements.

The Examiner asserts that inventions I. and II. are related as combination and sub-combination. This characterization of the claims is unsupported. The Examiner cannot show that the elements of one of the independent claims 1, 13 or 20 are fully present in the other of those claims so as to constitute a sub-combination of that other claim. In particular, each claim calls for two vehicle components, either a tractor and trailer in claim 1 or a first vehicle portion and a second vehicle portion in claims 13 and 20. Each of claims 1 and 13 calls for two hitch mechanisms, one associated with the first vehicle/tractor, the other associated with the second vehicle/trailer. Claim 20 calls for an articulated coupling between the first and second vehicle portions. The claims are thus coextensive insofar as they both claim the same significant elements. The vehicle portions are more particularly identified in the claims 1 and 20 and are left more generally described in claim 13 whereas the hitch components are more particularly described in claim 13 and left more generally described in claims 1 and 20. This does not make either a sub-combination of the other.

Applicants further traverse the Examiner's conclusion that claims 13-24 would not be classified under subclass 434 of class 446. The definition of subclass 434 is:

Tractor or Trailer:

Subclass 434. Device comprising either (1) a simulation of an on- or off-road vehicle which is specifically adapted to draw another vehicle or a piece of equipment, or (2) a simulation of an on- or off-road vehicle adapted to be drawn by another vehicle.

Independent claim 13 is directed to first and second vehicle portions having first and second hitches, respectively, connected thereto wherein the first hitch is configured in a particular, claimed configuration "for coupling with the second hitch assembly." It is respectfully submitted that the requirements for two vehicle portions and first and second hitches, coupling with one another, satisfies the requirement of this subclaim for a vehicle "specially adapted to draw ... or ... be drawn by another vehicle." There is but one toy vehicle embodiment described, a toy tractor-trailer combination, which is literally read upon by all of the claims including claim 13.

Independent claim 20 specifically calls for first and second vehicle portions "having a plurality of road wheels" and "an articulated coupling between the first vehicle portion and the second vehicle portion." Claims 21-23 are directed to the provision of motors in at least one of the two vehicle portions drivingly coupled with one or more of the road wheels of the two vehicle portion. These claims clearly fall within subclass 434.

Finally, the restriction requirement is clearly unsupported in view of MPEP § 806.03 which states:

806.03 Single Embodiment, Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

The application describes but a single embodiment. As explained above, the presented independent claims 1, 13 and 20 claim the same essential elements and vary in scope only with respect to those individual essential element characteristics. Accordingly, the restriction is unsupported.

For the foregoing reasons, the Examiner has failed to show that any of the independent claims represents a sub-combination of any other independent claim or that the claims are distinct based upon classification. Given that the independent claims all read upon and define the same essential characteristics of the single disclosed embodiment of the invention, restriction among the claims is absolutely not supported. M.P.E.P. 806.03.

For these reasons, the restriction requirement should be withdrawn and claims 13 through 24 should be examined. It is believed these claims are also allowable over the prior art of record in this application.

CONCLUSION

In view of the foregoing discussion, it is respectfully submitted that the present application, including claims 1-24 is in condition for allowance. Allowance of the application at an early date is respectfully requested.

Respectfully submitted,

Sean Mullaney et al.

7 January 2004
(Date)

By: 

JOHN JAMIESON
Registration No. 29,546
AKIN GUMP STRAUSS HAUER & FELD LLP
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, PA 19103-7013
Telephone: 215-965-1200
Direct Dial: 215-965-1310
Facsimile: 215-965-1210
E-Mail: jjamieson@akingump.com

JJ/MPH/vbm